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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/765,797	01/27/2004	Geert Deroover	226135	2587

23460 7590 11/03/2005

LEYDIG VOIT & MAYER, LTD  
TWO PRUDENTIAL PLAZA, SUITE 4900  
180 NORTH STETSON AVENUE  
CHICAGO, IL 60601-6780

EXAMINER
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HAMILTON, CYNTHIA

ART UNIT	PAPER NUMBER
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1752

DATE MAILED: 11/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/765,797

Applicant(s)

DEROOVER ET AL.

Examiner

Cynthia Hamilton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 7/21/05, 6/24/05, 5/02/05.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 4-12, 14-15, 17-19, 21-25, 27-28, 30-31, 33-34, 36 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 5, 8-9, 10-12, 14, 24-25, 27-28, 30-31, 33-34 is/are rejected.  
7) ☒ Claim(s) 1, 4-12, 14-15, 17-19, 21-24, 27-28, 30-31, 33-34, 36 is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. Applicants have amended the specification to remove objection of paragraph 1 in the last Office Action mailed 24 March 2005.
2. Applicants have amended claims 30-31, canceled claim 32, amended claims 33-34 and cancelled claim 35. The objections to claims 30-35 under 37 CFR 1.75 (c) set forth in paragraph 2 of the Office action mailed 24 March 2005 have been removed. These claims are now examined for the first time due to applicant's amendment.
3. Applicants canceled claims 2-3, 13, 16, 20, 26, 29, 32, and 35. Applicants newly added claim 36.
4. Claims 1, 4-12, 14-15, 17-19 and 21-24 are objected to because of the following informalities: There is a vertical line running through all of these claims. A clean set of claims without the line would remove this objection. Appropriate correction is required.
5. **This paragraph is for clarification of the record.** The examiner notes with respect to EP 1 162 078 A2 cited in the IDS of May 2, 2005, that applicants cited it in their IDS of January 27, 2004. As such, it has been fully considered by this Examiner as indicated in the signed IDS mailed to applicants on March 24, 2005. It is again reconsidered in view of the submitted European search report made of record by applicants. The European search report is not that of the document listed by applicants as the European application set forth for foreign priority in this application. EP 1 473 156 A2 is the published European application of European application Number 04100162.9, i.e., the application from which comes the submitted search report. This document claims priority to EP 03100154 that is the application to which applicants claim foreign priority in the instant application.

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6. Applicant is advised that should claim 4 be found allowable, claim 36 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

7. Applicant is advised that should claim 12 be found allowable, claim 14 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

8. Applicant is advised that should claim 15 be found allowable, claim 17 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

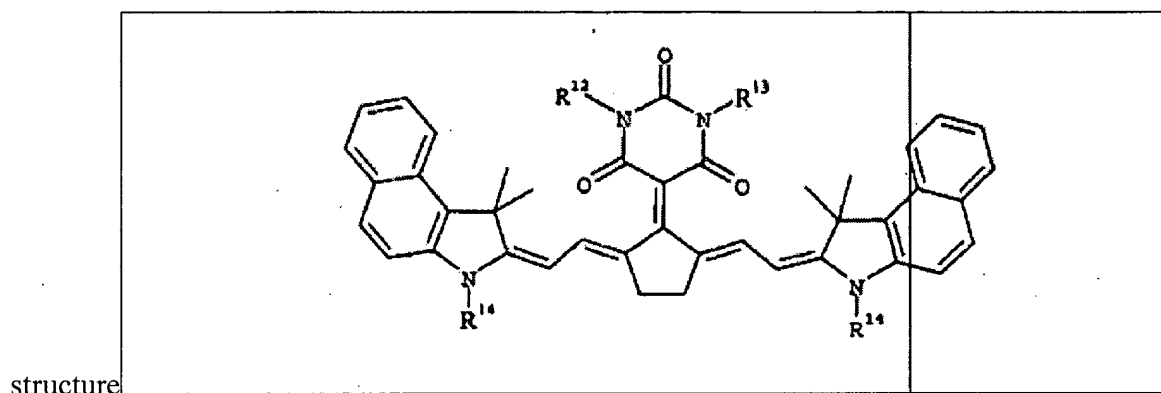
9. Applicant is advised that should claim 19 be found allowable, claim 21 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

10. The examiner notes that claims 24 and 25 differ by the last provision in claim 25 which is not present in claim 24.

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11. The following set of rejections are made in view of the limitation to claim 1 and the clear presentation in original claims of dyes which do not read on the limitation now present in claim

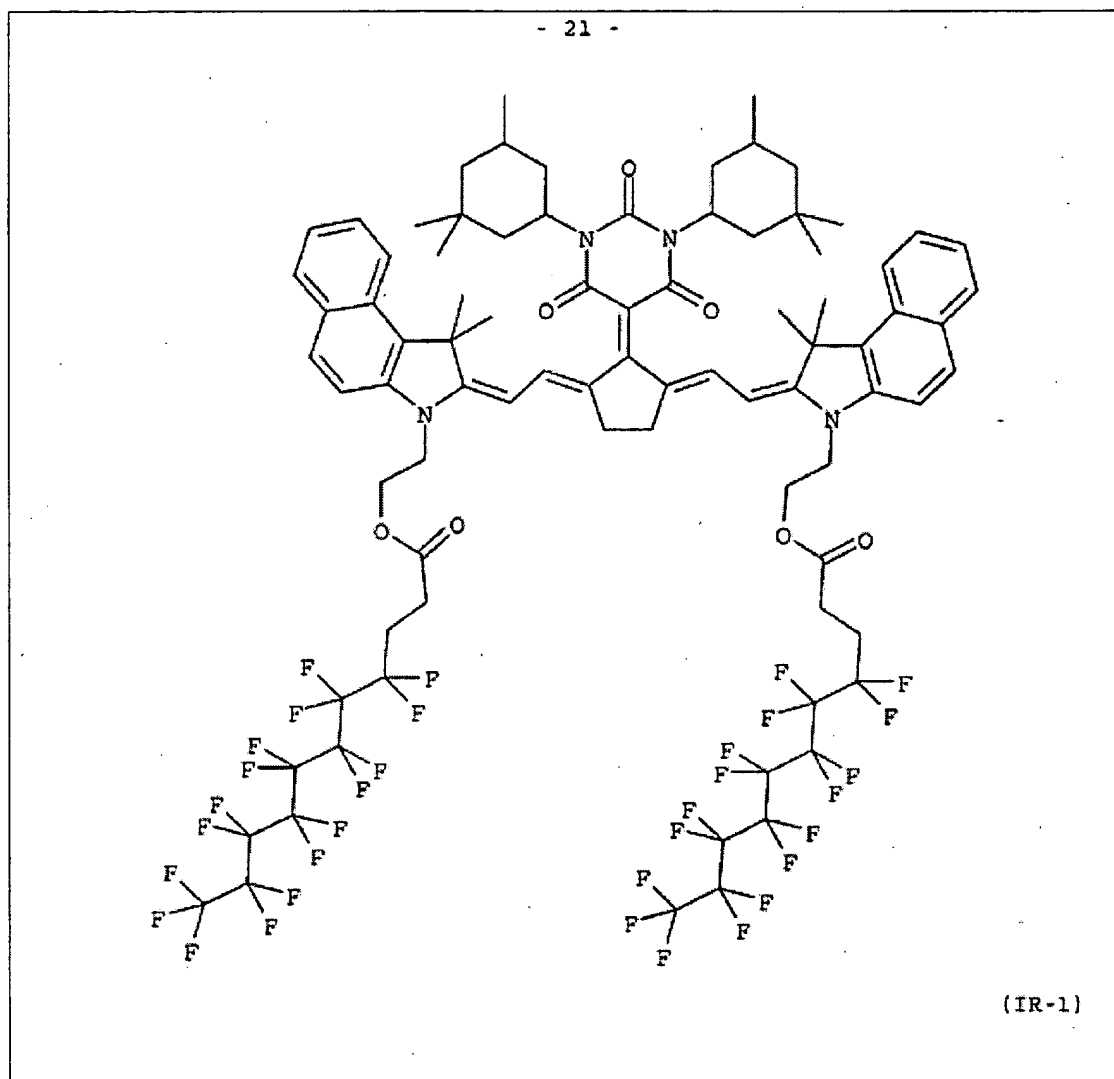
1. The clear evidence of problems is seen in claim 11 with the following



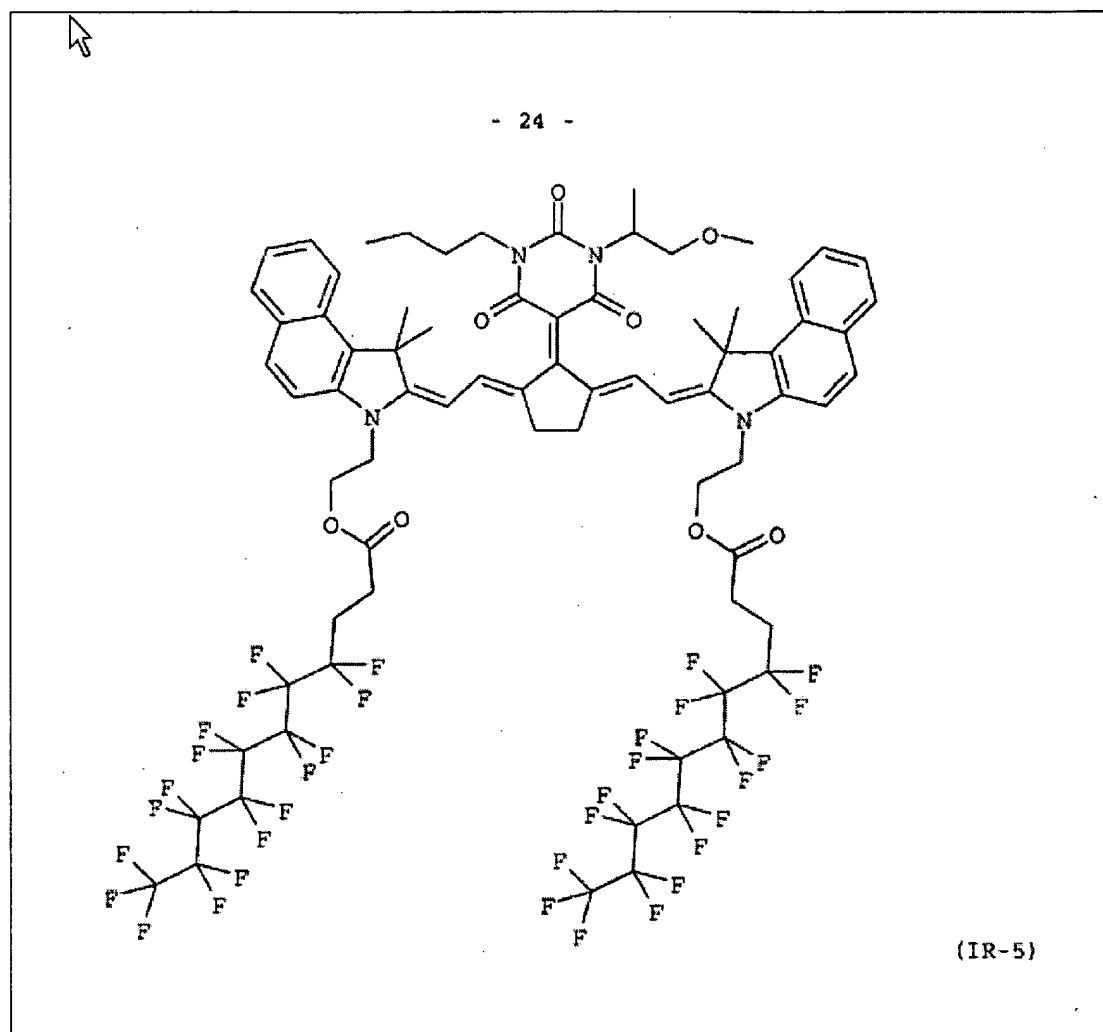
$R^{14}$  and  $R^{12}$  and  $R^{13}$  are only the only charge groups but no counter ion is shown in the structure nor is there an example of a dye with a counter ion present. The only example given in the original specification is from page 21 the

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following:



From page 24 the following:



There is no indication any counter ion other than the metal was envisioned for the metal thioline dyes as first found in claim 5.

12. The following is a quotation of the first paragraph of 35 U.S.C. 112:

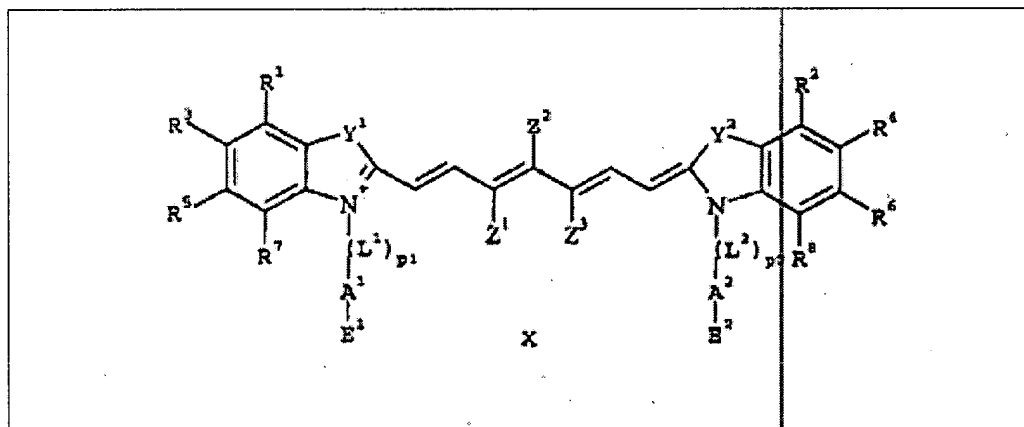
The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

13. Claims 5, 8, 9, 10, 11, 12, 14, 24, 25, 27-28, 30-31, 33 and 34 are rejected under 35

U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to

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reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. With respect to the requirement in claim 1 that the “infrared absorbing dye” comprises “at least one perfluoroalkyl group, wherein the infrared light absorbing dye carries a charge and at least one perfluoroalkyl group is included in a counter ion and contains at least 6 fluorine atoms”, applicants have failed to show support for this limitation in all of the dyes listed in claims 5, 8, 9, 10, 11, 12, 14, 24, 25, 27-28, 30-31, 33 and 34. Applicants has not pointed out where the amended (or new) claim is supported, nor does there appear to be a written description of the claim limitation “at least one perfluoroalkyl group, wherein the infrared light absorbing dye carries a charge and at least one perfluoroalkyl group is included in a counter ion and contains at least 6 fluorine atoms ” found in the application as filed with respect to metal ditholine dyes,



wherein X is

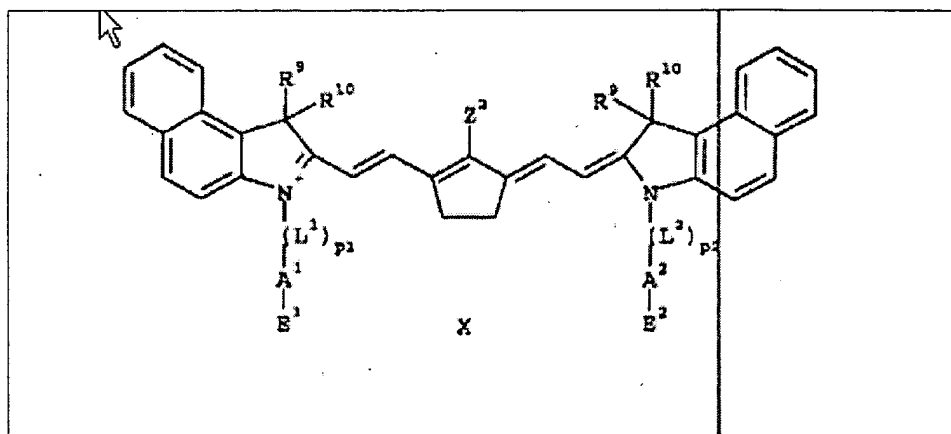
optional and optionally comprised a perfluoroalkyl group containing at least 6 fluorine atoms, and wherein X is not a perfluoroalkyl group as indicated by

with the proviso that at least one of the following substituents contains a perfluoroalkyl group: -A <sup>1</sup> -, -A <sup>2</sup> -, R <sup>1</sup> to R <sup>11</sup> or X.	
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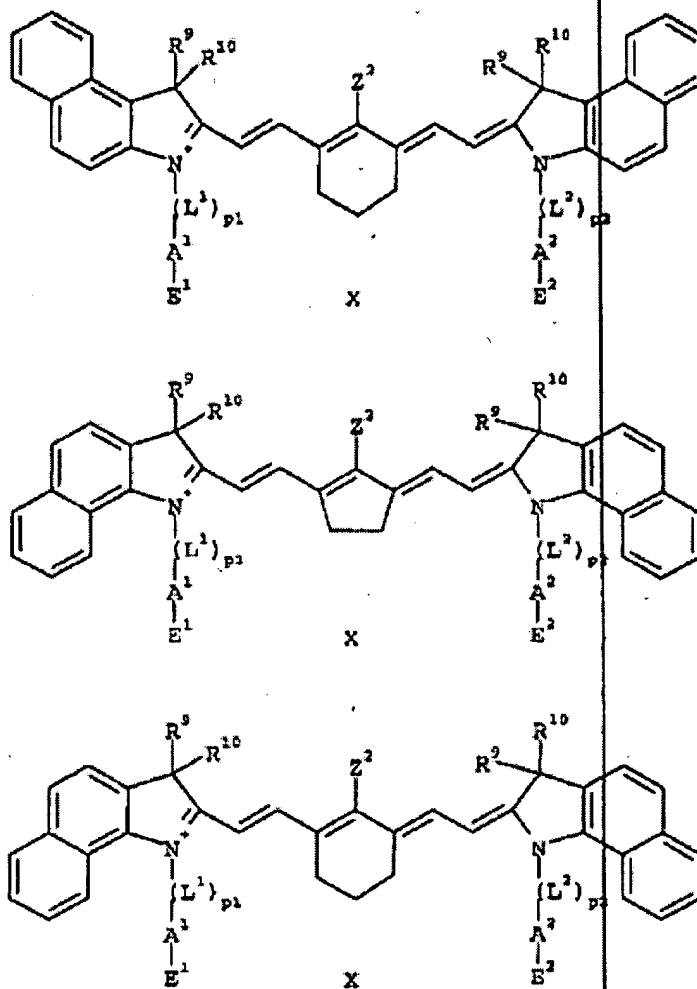
from claim 8, wherein the dye is



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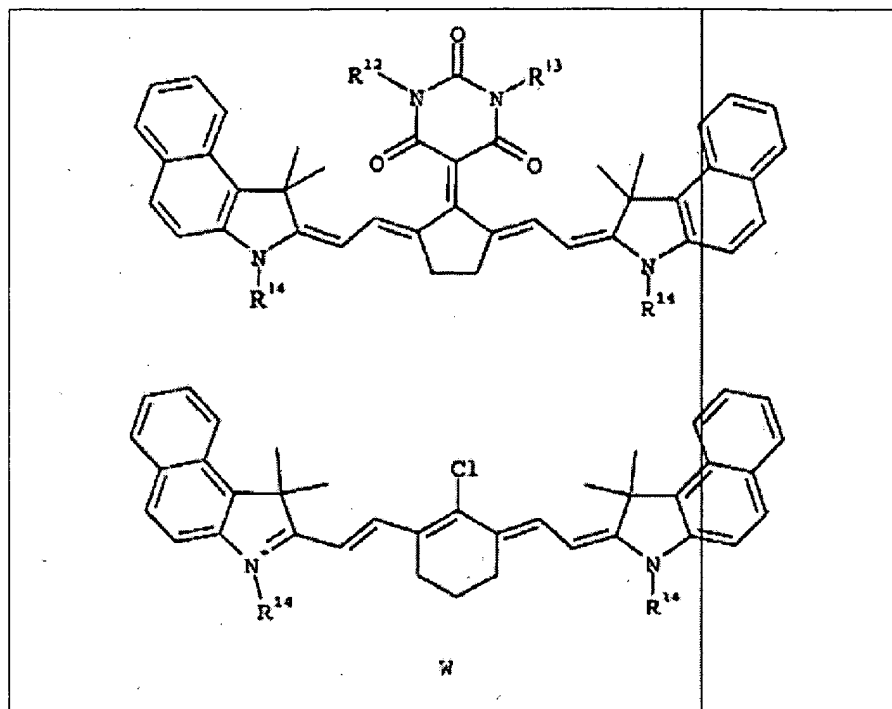
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Reply to Office Action



wherein  $p_1$ ,  $p_2$ ,  $-L^1-$ ,  $-L^2-$ ,  $-A^1-$ ,  $-A^2-$ ,  $-E^1$ ,  $-E^2$ ,  $R^9$ ,  $R^{10}$ ,  $Z^2$  and X have the same meaning as defined in claim 8.

or



The examiner notes that these are in several claims and because of the insertion of now cancelled claim 3 into claim 1, the issue of whether the limit of claim 3 was ever clearly disclosed to encompass the dyes now considered to be thus limited in the original claims the issue of original disclosure for these dyes under these limits is presented. See particularly MPEP 2163.04.

14. Claims 5, 8, 9, 10, 11, 12, 14, 24, 25, 27-28, 30-31, 33 and 34 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. If claims 5, 8, 9, 10, 11, 12, 14, 24, 25, 27-28, 30-31, 33 and 34 are not intended to be fully limited by the now amended claim 1 then all the issues set forth above with respect to the “optional” or lack of presence of the “infrared absorbing dye” comprises “at least one perfluoroalkyl group, wherein the infrared light absorbing dye carries a charge and at least one perfluoroalkyl group is included

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in a counter ion and contains at least 6 fluorine atoms” gives evidence that the scope of these claims may be intended to broaden the invention of claim 1 instead of limit it further. This is improper dependence under 37 CFR 1.75 (c). If broadening was intended, the claims are objected to as being outside the limits of claim 1.

15. Because of the confusion as to the limits of the claims, the examiner has noted that the prior art of record does not look as if it reads on claim 1 as set forth by applicants but is not sure how to address the issue of prior art due to the myriad of interpretations of the whole set of claims presented. In view of this, no further new examination over the prior art is considered until the scope of the claims is clarified by applicants.

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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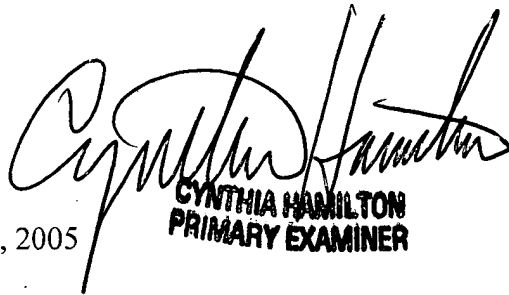
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cynthia Hamilton whose telephone number is 571-272-1331.

The examiner can normally be reached on Monday through Friday 9:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly can be reached on (571) 272-0729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

October 31, 2005



**CYNTHIA HAMILTON  
PRIMARY EXAMINER**

Cynthia Hamilton  
Primary Examiner  
Art Unit 1752